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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,098	02/05/2001	Robert Bernstein	4707-81342	1323
24628 7590 12/18/2006 WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606			EXAMINER CARLSON, JEFFREY D	
			ART UNIT 3622	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	
3 MONTHS			12/18/2006	
			DELIVERY MODE PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/777,098

Applicant(s)

BERNSTEIN, ROBERT

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to 131 Affidavit

The 131 affidavit filed on 8/10/06 under 37 CFR 1.131 has been considered but is ineffective to overcome the applied art.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Oytac reference to a constructive reduction to practice.

While the claimed subject matter appears to have been possessed prior to the Oytac filing date (7/31/00), there are apparent periods of inactivity that lead examiner to conclude a lack of diligence to constructively reduce the invention to practice (instant applicant was filed 2/5/2001). The critical period (7/31/00 to 2/5/2001) for which diligence must be shown is slightly more than 6 months. The evidence to support diligence comprises:

- Mr. Jon Christensen was contacted 10/02/2000 to begin preparing a patent application.
- An email was sent 12/7/2000 detailing features of an invention.

However, neither one of these (especially the email's invention details) mention anything about 3rd party privacy. While it is clear that some work was done on these two dates, the subject matter of this work does not appear to be the same as the claimed invention.

("[a]ctivity directed toward the reduction to practice of a genus does not establish, *prima facie*, diligence toward the reduction to practice of a species embraced by said genus"); *Justus v. Appenzeller*, 177 USPQ 332, 340-1 (Bd. Pat. Inter. 1971). The work relied upon must be directed to attaining a reduction to practice of the subject matter of the counts. It is not sufficient that the activity relied on concerns related subject matter." *Gunn v. Bosch*, 181 USPQ 758, 761 (Bd. Pat. Inter. 1973). MPEP 2138.06.

Further, there are gaps of time that are unexplained. "*the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application* (filing constitutes a constructive reduction to practice, **37 CFR 1.131**)." MPEP 715.07 III.

It is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; the USPTO or courts will not speculate on possible explanations for delay or inactivity. See *In re Nelson*, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970). MPEP 715.07(a).

An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964).

A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983).

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 2-4, 10-12 are inconsistent with the embodiment(s) of the base claim. The base claim states that customer data is released to the vendor in summary form which appears to be consistent with the specification page 5 where the released information is contact information (such as an email address). In these embodiments, the promotional materials are delivered to the customer through channels other than the POS, yet claims 2-4 and 10-12 appear to describe only the embodiment where promotional delivery is accomplished via the POS. Applicant's claims conflict with different embodiments in the specification and lead to confusing claim scope.
- Claims 9, 17 are apparatus claims, yet they are presented with limitations that appear to be method steps rather than structure, rendering the claim scope unclear. Applicant should clearly further limit the apparatus with structure (i.e. elements of the apparatus which are *programmed or configured* to carry out

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the recited functionality). Claim 9 includes means for forming which is proper structure, however "customer data is released" is not structure. Claim 17 recites "information provided by...vendors" – it is unclear how the source or delivery mechanism of this information can limit the structure of the database in this system claim. Is this a step of providing?? Claim 17 further includes "customer data is released" which is not structure.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-5, 8-13, 16-19, 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Oytac (2003/0018613). This published application enjoys the earlier benefit of and incorporates by reference 60/221774 (filed 7/31/00). This Office Action shall refer to the disclosure of 60/221774 by page number rather than the 2003/0018613 document.**

5. Regarding claims 1, 9, 17, Oytac teaches information providers (banks, credit card processors) that compile detailed user profiles concerning the user's purchasing histories. This is taken to provide a third party database. Information users (vendors)

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define desired user profiles who are to receive targeted promotional materials.

Customers who match the defined profiles are selected as the recipients of the defined promotional materials [pg 1 of 60/221774]. While no particular step of “requesting” by customers is claimed, customers who make purchases with such credit cards are taken to implicitly give their permission for collection of such purchase data which forms the customer profiles. Oytac teaches that an interface is provided for a vendor to define the desired profile characteristics and the promotional materials to be delivered [pg 2, fig 1 of 60/221774]. The system of Oytac performs a matching of stored profiles and defined desired profiles and is taken to meet the comparator/searching limitations. Oytac states that the vendors may view customer information stored in its 3rd party database, but only in aggregate (or summary) form [pg 1]. Oytac’s system then can automatically deliver the promotional materials.

6. Regarding claims 2-4, 10-12, 18, 19, Oytac teaches that a POS system can provide trigger-driven promotions printed on a receipt [pg 4]. Oytac teaches that the promotions can include coupons [pg 2].

7. Regarding claims 5, 13, Oytac teaches a promotional delivery channel using email [pg 4].

8. Regarding claims 6, 14, 20, the broad limitation that the promotional materials include “indicia of authenticity” without any corresponding steps or feature to verify the authenticity of such indicia can be met by any indicia printed on the promotion of Oytac. The printed materials of Oytac are taken to inherently include at least some “indicia”.

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9. Regarding claims 8, 16, 22, Oytac teaches an example where promotions are based upon types of purchases [pg 5]. Oytac also teaches the use of product categories [pg 22].

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claims 7, 15, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oytac in view of Katz (US20020077901). Page 10 of Katz's 60/256324 has been included to demonstrate support for the important feature to 12/19/2000.**

12. Regarding claims 7, 15, 21, Oytac teaches targeting to users based upon location [pg 5], but not necessarily based upon purchase location. Katz teaches custom promotions offered to users that includes various user profile parameters including locations where purchases were made [¶ 40].

Response to Arguments

13. Applicant argues that claims 2-4, 10-12 are consistent because even when a promo is delivered via POS, the vendor would still require the right to audit customer results found by a database search for customer profile. It is unclear how an audit is

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relevant to this rejection. These dependant claims specify that the promo is sent via POS, yet the base claim appears consistent with promos sent by non-POS means.

14.

Conclusion

This is responsive to the RCE filed 9/11/06 whereby all claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-

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6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc